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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,009	12/27/2000	Paul Giotta	FREI.P049	6616

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OPPEDAHL & OLSON LLP  
P.O. BOX 5388  
DILLON, CO 80435-5388

EXAMINER
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DUONG, THOMAS

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/750,009

Applicant(s)

GIOTTA, PAUL

Examiner

Thomas Duong

Art Unit

2145

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 18 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 1-21.  
Claim(s) withdrawn from consideration: None.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Please see continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
**JASON CARDONE**  
**SUPERVISORY PATENT EXAMINER**

## DETAILED ACTION

### *Response to Argument*

1. The Applicants' arguments and amendments filed on December 18, 2005 have been fully considered, but they are not persuasive.
2. With regard to claims 1-21, the Applicant's representatives point out that:
  - *Impossible to combine. In the previous Office Action the Examiner had rejected all claims over a two-way combination of two references. The Examiner had stated that it supposedly would have been obvious (at the time of the filing of the present application in December of 2000) to combine the two references. The undersigned pointed out that at the time of the filing of the present application, one of the references was in fact secret within the USPTO pursuant to 37 CFR 1.14. The undersigned pointed out that the soonest that anyone, regardless of whether or not they were skilled in the art, could have combined the references was when the second one finally for the first time became public, namely in October of 2004.*

However, the Examiner finds that the Applicant's representatives arguments are not persuasive, because according to 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This means that the prior arts used in the 35 U.S.C. 103(a) rejection just needs to comply with the rules of section 102, which states:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Hence, the Camp et al. (US006802067B1) and Codella et al. (US006804818B1) references satisfy the requirements to be used as prior arts in the 35 U.S.C. 103(a) rejection.

3. With regard to claims 1-21, the Applicant's representatives point out that:

- In the December 15, 2005 Office Action, the Examiner has said nothing to refute this fact about one of the references having been secret at the time it was supposedly so obvious to combine it with some other reference. And indeed the Examiner cannot refute this. The Examiner's only response is to quote 35 USC 103. But Section 103 in no way refutes the simple unavailability of the secret Camp reference at the time it was supposedly available to be combined in December of 2000.*
- If it was so obvious to combine the two references in December of 2000, the undersigned challenges the Examiner to explain why the Examiner did not cite the two references in the March 8, 2004 Office Action or in the October 1 , 2004 Office Action.*

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However, the Examiner finds that the Applicant's representative arguments are not persuasive, because they are mute due to the explanations of qualified prior arts used in the 35 U.S.C. 103(a) rejection above.

4. The declaration filed on October 2, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Camp et al. (US006802067B1) reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Camp et al. (US006802067B1) reference to either a constructive reduction to practice or an actual reduction to practice. The evidence to establish diligence from a date prior to the date of reduction to practice of the Camp et al. (US006802067B1) reference to either a constructive reduction to practice or an actual reduction to practice is requested from the applicants' representatives.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Camp et al. (US006802067B1) reference. The evidence to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Camp et al. (US006802067B1) reference is hereby requested from the applicants' representatives.